


05-12-05

3732

TRANSMITTAL LETTER (General - Patent Pending)				Docket No. 110/02242	
In Re Application Of: Oren GLOBERMAN, et al					
Application No. 09/890,318	Filing Date July 25, 2001	Examiner PHILOGENE, P.	Customer No. 44909	Group Art Unit 3732	Confirmation No. 9263
Title: EXPANDABLE ELEMENT DELIVERY SYSTEM					
<u>COMMISSIONER FOR PATENTS:</u>					
Transmitted herewith is:  Response to Office Action dated February 10, 2005					
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Paul FENSTER Reg. No. 33,877					
William H. Dippert, Esq. Reed Smith LLP 599 Lexington Avenue, 29th Floor New York, NY 10022-7650  Tel: (212) 521-5450					
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Applicant: Oren Globerman, et al.  
Serial No: 09/890,318  
Filing Date: July 15, 2001  
For: EXPANDABLE ELEMENT DELIVERY SYSTEM  
Enclosures: (1) Transmittal [2 pages];  
(2) RESPONSE [3 pages];  
(3) PTO-1449s [8 sheets];  
(4) Acknowledgement Postcard.

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110/02242 A07

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Oren GLOBERMAN et al.

Serial No : 09/890,318

Filed : July 25, 2001

For : EXPANDABLE ELEMENT DELIVERY SYSTEM

Examiner : Pedro PHILOGENE

Group Art Unit: 3732

Mail Stop Amendment  
Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE**

Sir:

This letter is in response to an Office Action dated February 10, 2005, in the above referenced application. The present application includes claims 1-89 and 100-173. Claims 73-89 and 100-173 were allowed.

In the following discussion applicants relate to independent claim 1. The dependent claims are allowable at least by virtue of their parent claim.

Claims 1-8, 11, 12, 15, 17, 18, 22, 34, 35, 37, 39, 40, 42, 47-49, 58 and 68 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bachmann et al. (5,759,186). Claims 43-46, 59, 60 and 63-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bachmann et al. (5,759,186). Applicants respectfully traverse the rejection and state that the Examiner has not established a *prima facie* case of unpatentability, as Bachmann lacks at least one limitation of the claim.

Claim 1 requires a force application mechanism for applying a deforming force to the implant, by axial motion of a force applicator against the implant. This is not taught or suggested by Bachmann, which teaches a stent 33 which is expanded by retraction of an outer tube 9, which holds the implant in a compressed form (col. 6, lines 51-64). The axial motion applied by Bachmann is used for axial displacement of the outer tube relative to the central tube (col. 1, lines 61-63) and is not applied against the implant, as required by claim 1.